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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/502,133	02/11/2000	Harold E. Helson	103544.127	4787

7590

10/09/2003

Jason A. Reyes  
Hale and Dorr LLP  
60 State Street  
Boston, MA 02109

EXAMINER

THOMSON, WILLIAM D

ART UNIT	PAPER NUMBER
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2123

DATE MAILED: 10/09/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

44

**INFORMATION REQUIREMENT**

***Requirement For Information - 37 C.F.R. § 1.105***

**I. Applicant and Assignee of this application are required under 37 C.F.R. 1.105 to provide the following that the Examiner has determined is reasonably necessary to the examination of this application.**

This request is made in view of the prosecution history with arguments made by Applicant and will assist in determining whether certain references constitute prior art against specific claims. Examiner's rejection, paper 7, under 35 U.S.C. 102(b), asserted that the software models having dates of July 1996 constitute prior art admittances. If these models prove to be required for enabling the invention as recited and are in one of Applicant's many commercial products as early as 1996, the product using this code would constitute a statutory bar against that claimed subject matter.

To make the record clear the examiner is requiring specific information that may be used to delineate the invention and the commercially available products in the CambridgeSoft series of products. ChemDraw, ChemFinder and Chem3D packages prior to February 1998 are of particular interest. Examiner has had experience with the Macintosh versions of ChemDraw 1.0 and Chem3D 1.0 in 1987. Examiner has provided a listing of ChemDraw and Chem3D version histories as support for knowing of the prior products with the accompanying PTO 892. These related information, products and documents, written by the inventor or an employee of the assignee, and which were not submitted, were uncovered during the search or described in the application file. Further, the named articles below, as recited from the specification as

filled, have not been provided by Applicant in a proper IDS and are now required. As the breadth and scope of the claims pending apparently encompasses the earlier versions dating back prior to February 1998 it is proper to require disclosure of the following. see M.P.E.P. 704.11 sections relating to requirements, and 37 C.F.R. 1.105(a)(i)-(vii).

**In response to this requirement, please provide:**

1. The publication date or date of sale of supportive documentary evidence, such as manuals, articles and/or program code by applicant, or assignee, that may qualify as printed publication prior art or on sale bar (35 U.S.C. 102(a) or (b)) specific to the CambridgeSoft series for the ChemDraw, ChemFinder, Chem3D, inclusive of support programs and add-ons that allow for integration between these specific packages, that were available prior to February 11, 1999.
2. The trade name of any goods or services the *claimed* subject matter is embodied in.
3. The citation for, the dates *initially* published and copies of any advertising and promotional literature prepared for any goods or services the *claimed* subject matter has been embodied in.
4. The citation for and copies of any journal articles describing any goods or services the *claimed* subject matter has been embodied in.
5. The claimed invention appears to be an improvement over at least some of Applicant or Assignee's commercial products, identification of what is being improved must be provided in the response so as to delineate the *claimed* invention from these products.

6. Copies or originals of manuals covering versions ChemDraw 1-4.5, ChemFinder 1-4.0, and Chem3D 1.0-4.5.

7. Copies of the following article mentioned in the specification in an apparent attempt at incorporating its subsection matter therein, yet not provided in the filed IDS, paper 4. This was originally requested in the Office Action dated January 15, 2003, paper # 7.

H.E. Helson, "Structure Diagram Generation", in Reviews in Computational Chemistry, K. B. Lipkowitz et al., Wiley-VCH, New York, 1999, vol. 13, at 313-398. Incorporated in specification and used for support on pages 4 and 14.

8. Any written descriptions or analyses, prepared by any of the inventors or assignees, of goods or services in competition with the goods or services the *claimed* subject matter has been embodied in.

9. An explanation of technical material held within the publications, specific to the publications listed on the PTO 1449 and those referenced within the specification so as to delineate the inventor's subject matter and that subject matter contributed by others listed as co-authors, but not listed as co-inventors. Further, this explanation must go to how the subject matter supports the instant specification as filed and how the instant invention teaches different and patentably distinguishable subject matter that Applicant regards as their invention and *claimed*.

10. An explanation and analysis of how the subject matter *claimed* is patentably distinct from that which is taught in the CambridgeSoft suite of software inclusive of ChemDraw, Chem3D and ChemFinder, prior to February 11, 1999.

This request is made in view of the prosecution history with arguments made by Applicant with prior art provided and will assist in determining whether uncovered references and commercially available products might constitute prior art against specific claims pending in the application.

The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 C.F.R. 1.56. Where the applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained will be accepted as a complete reply to the requirement for that item.

The fee and certification requirements of 37 C.F.R. 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 C.F.R. 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 C.F.R. 1.105 are subject to the fee and certification requirements of 37 C.F.R. 1.97.

This requirement is subject to the provisions of 37 C.F.R. 1.134, 1.135 and 1.136 and has a shortened statutory period of 2 months. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 C.F.R. 1.136(a).

### NOTICE OF REFERENCES CITED

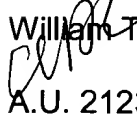
The prior art made of record, listed on the accompanying PTO 892, has not yet been relied upon but is considered pertinent to applicant's disclosure. Examiner is merely making this art of record. This listing is inclusive of the ChemDraw and Chem3D version history and general product information pertaining to assignee's product lines.

### Correspondence Information

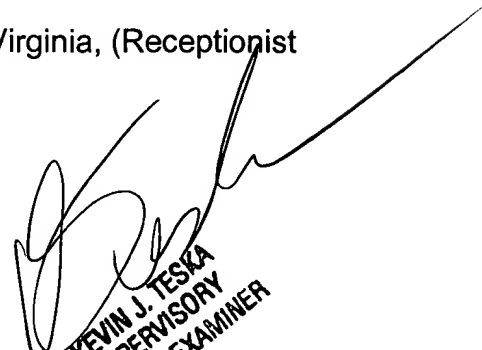
II. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to William Thomson whose telephone number is (703) 305-0022. The Examiner can normally be reached on Monday, Tuesday, Thursday and Friday from 6:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's Supervisor, Kevin Teska can be reached at (703) 305-9704.

Any response to this office action should be mailed to: Director of Patents and Trademarks Washington, D.C. 20231 or faxed to: (703) 746-7238, (for formal communications intended for entry) Or: (703) 746-7240 (for informal or draft communications, please label "PROPOSED" or "DRAFT") Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive Arlington, Virginia, (Receptionist located on the sixth floor).

  
William Thomson  
A.U. 2123

9/29/03

  
KEVIN J. TESKA  
SUPERVISORY  
PATENT EXAMINER